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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,537	01/02/2001	David L. Multer	FUSN1-01003US0	1714
28554	7590	12/04/2003	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			RONES, CHARLES	
			ART UNIT	PAPER NUMBER
			2175	12

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,537

Applicant(s)

MULTER ET AL.

Examiner

Charles L. Rones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Preliminary Amendment

The preliminary amendment timely filed on January 2, 2001 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80-116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/ 753,643.

Claims 80-116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/ 753,644.

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Although the claim wording is not the same, the metes and limitations are have only slight differences, which are arguably broader than those in the present application.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 80-87, 90-97, 100-102, and 105-116 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodnar U.S. Patent No. 6,295,541 ('Bodnar').

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Bodnar discloses:

As to claim 80,

computer code for comparing at least one file on the personal computer and a record of the file on the computer, and providing binary differencing data between the file and the record of the file; See 23:26-67; 25:12-35; and

a transaction generator providing at least one binary difference transaction including said binary differencing data to an output; See 23:26-67; 25:12-35.

As to claim 81,

wherein the output is coupled to a network, and the synchronizer is operatively coupled to at least one storage server via the network, the storage server receiving said difference transaction from said synchronizer; See 23:26-67; 25:12-35.

As to claim 82,

wherein the synchronizer receives at least one binary difference transaction from the storage server, and further including computer code for applying the received difference transaction to the at least one file on the device; See 23:26-67; 25:12-35.

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As to claim 83,

wherein the synchronizer includes code for updating the record of the file on the device subsequent to applying the received difference transaction; See 23:26-67; 25:12-35.

As to claim 84,

wherein the output 1 is coupled to a second synchronizer and the binary difference transaction is provided to said second synchronizer; See 23:26-67; 25:12-35.

As to claim 85,

wherein the second synchronizer is on said device; See 23:26-67; 25:12-35.

As to claim 86,

wherein the second synchronizer is coupled to a network, and the output of the transaction generator is coupled to the network and the second synchronizer; See 23:26-67; 25:12-35.

As to claim 87,

wherein the output is coupled to a network and the synchronizer is operatively coupled to at least one storage server via the network receiving said difference transaction from said synchronizer via the network, and the second synchronizer is coupled to the storage server; See 23:1-67; 25:12-35.

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As to claim 90,

wherein the computer code for comparing at least one file on the personal computer includes Xdelta; See 22:15-31; 23:26-67; 25:12-35.

As to claim 91,

an application data access routine; See 10:23-57;

a differencing transaction generator including binary difference data extractor;

See 11:1-64;

a user interface; See 22:15-31; 23:26-67; 25:12-35; and

a network transfer routine; See 22:15-31; 23:26-67; 25:12-35.

As to claim 92,

wherein the nonvolatile storage apparatus is a local storage device in a computer; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 93,

wherein the nonvolatile storage apparatus comprises a network storage apparatus; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

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As to claim 94,

wherein the computer code is provided in an installation package further including an installation routine; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 95,

wherein the differencing transaction generator determined difference data based on comparing at least one file to a record of said at least one file; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 96,

wherein the differencing transaction generator outputs instructions to add, delete or modify the file based on the difference data extracted; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 97,

wherein the binary difference data extractor comprises Xdelta; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

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As to claim 100,

a system installation routine; See Fig. 2; 22:15-31; 23:26-67; 25:12-35;

a binary difference transaction generator, the binary difference transaction including a binary difference comparison between a first file and a previous version of said first file; See Fig. 2; 22:15-31; 23:26-67; 25:12-35; and

a network coupling routine; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 101,

wherein the installation routine is determined based on a type of device for which the installation package is intended; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 102,

wherein the application data access routine includes a file system access routine; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 105,

wherein the installation package is accessible via the World Wide Web; See 12:12-41.

As to claim 106,

on a nonvolatile storage medium; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

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As to claim 107,

wherein the nonvolatile storage medium is a local storage device in a network coupled processing device; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 108,

wherein the nonvolatile storage medium is a network storage server; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 109,

computer code for comparing at least one file on a network coupled device in communication with the network coupled server and extracting binary differencing data representing the difference between the file and a record of the file; See Fig. 2; 22:15-31; 23:26-67; 25:12-35; and

a transaction generator providing at least one transaction including said binary differencing data to an output; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 110,

wherein the record of the file is provided on the network coupled device; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 111,

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wherein the record of the file is provided on the network coupled server; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 112,

wherein the record of the file is a previous version in time of the file. ; See Fig. 2; 22:15-31; 23:26-67; 25:12-35

As to claim 113

wherein the synchronizer further includes application code to modify a second version of the file by applying said binary differencing data to the second version of the file; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 114,

wherein the second version of the file is on a second network coupled device; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

As to claim 115,

wherein the second version of the file is on the network coupled server; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

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As to claim 116,

at least a first binary differencing engine coupled to a first network coupled device; See Fig. 2; 22:15-31; 23:26-67; 25:12-35;

at least a second binary differencing engine coupled to a second network coupled device; See Fig. 2; 22:15-31; 23:26-67; 25:12-35; and

a storage device coupled to the first and the second network coupled devices storing binary differencing data from and outputting binary differencing data to said at least first and second binary differencing engines; See Fig. 2; 22:15-31; 23:26-67; 25:12-35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 88-89, 98-99, and 103-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar U.S. Patent No. 6,295,541 ('Bodnar') in view of Gutman et al. U.S. Patent No. 5,130,993 ('Gutman').

Bodnar discloses the claimed invention except for wherein the synchronizer further includes an encryption routine encrypting the difference transaction; wherein the synchronizer further includes a compression routine; further including an encoder

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routine operable on said differencing transaction. Gutman teaches that it is known to provide wherein the synchronizer further includes an encryption routine encrypting the difference transaction; wherein the synchronizer further includes a compression routine; further including an encoder routine operable on said differencing transaction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the synchronizer further includes an encryption routine encrypting the difference transaction; wherein the synchronizer further includes a compression routine; further including an encoder routine operable on said differencing transaction as taught by Gutman, since Gutman states in the Abstract that such a modification would reduce errors when transmitting over an unreliable network by checking for transmission errors after decoding.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Rones whose telephone number is 703-306-3030. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.



Charles L. Rones
Primary Examiner
Art Unit 2175

November 29, 2003